

### **REMARKS**

The above referenced Office Action has been carefully reviewed and reconsideration of this application is respectfully requested in view of the above amendments and the following remarks. In the interest of clarity, the paragraph numbers below correspond to the paragraph numbers in the Office Action.

#### **Section 103 Rejection**

1. Claims 1 – 158 were rejected as obvious over Rothschild in view of Foote (6,036,231). Applicant respectfully traverses this rejection.

As described in Applicant's response to the April 10, 2003 Office Action, there are generally two different categories of indicating configurations for use with containers including configurations that cooperate with data collecting devices to gather information therefrom and configurations that do not cooperate with data collecting devices. Hereinafter, configurations that cooperate with data collectors are referred to as "enhanced containers" and other configurations are referred to as "non-enhanced containers".

A general perusal of the known medical container configuring art makes clear that prior references generally assume either a system including all enhanced containers or a system including all non-enhanced containers. This is not surprising as, generally, references that teach smart or enhanced containers typically teach the advantages of smart containers over, and teach away from, non-enhanced containers that only include human readable indicia.

In a system that assumes all containers are enhanced (e.g., containers with some type of machine readable information), there is no need to determine if an enhanced or a non-enhanced container is required to fill a prescription. Instead, because it is assumed that all medicant users have the capability to use enhanced containers, an enhanced container is always automatically provided.

#### **Claims 1 – 158 are not Obvious in light of cited prior art**

Claim 1 is different than Rothschild in both form and function. With respect to function, the claim 1 invention is provided to reduce order filling costs where some orders are filled using enhanced containers (i.e., containers including devices that

are usable in conjunction with a data collector to gather information) and other orders are filled using non-enhanced containers. Consistent with this order filling cost reducing function, with respect to form, claim 1 is limited to an apparatus that, among other things is (1) used with indicating configurations where at least a subset of the configurations include an enhanced memory device (2) where at least one descriptor that can be used to identify the indicating configuration and the data to be stored via the indicating configuration is associate with each orders, the apparatus including (3) a reader for reading the descriptors, (4) a writer for writing data to enhanced devices, (5) a processor that uses a descriptor to identify when enhanced data is associated with an order and that causes a writer to write enhanced data to an enhanced device when enhanced data is associated with an order, the (6) processor causing another indicating function to be performed when enhanced data is not associated with an order.

Thus, claim 1 contemplates a system wherein a descriptor is stored with each order that indicates when enhanced data should be included on a container used to fill the order and a system that uses the descriptor to determine when enhanced data should be included and that provides the enhanced data on an enhanced device when appropriate. Here, for instance, instead of requiring a pharmacist to determine if and when enhanced data should be included with a container, to select an appropriate container and to write enhanced data to the selected container, the inventive system automatically makes the determination and configures appropriately.

In contrast to reducing the costs of filling prescriptions in a system that includes both enhanced and non-enhanced containers by streamlining the container configuring process, Rothschild's function is to provide a warning when a time period associated with a product has lapsed. For instance, in the case of medications, manufacturers usually specify a medication expiration date. As another instance, in maintenance service industries (i.e., auto, machine equipment, etc.), the times between routine maintenance service requirements is usually specified. Rothschild's system is for reminding product users of expired time periods associated with product, machines, systems, etc.

With respect to form, Rothschild teaches that a timing label may be provided on a product container, machine, etc., that times out a period and, at the end of the period, generates a warning that the period has lapsed. For instance, in the case of a medication in a container, a timing label may be placed on the external surface of the container and programmed to generate a warning when an expiration period has lapsed. To program the period duration to be timed out, Rothschild contemplates a computer 32 (see Fig. 5) that receives a desired end date on which the period should lapse (see col. 9, lines 50-57) from an operator (i.e., a person). Thereafter, the computer determines a pulse count for the timing label that corresponds to the end date and stores the pulse count on the timing label. Rothschild's warnings are either audible or visual and do not provide information that can be gathered by another device.

Thus, with respect to form, despite statements to the contrary in the Office Action, Rothschild fails to teach or suggest virtually every element of claim 1. First, Rothschild fails to even suggest an apparatus for use with at least some enhanced devices. Here, Rothschild's timing label is not an "enhanced device" as that phrase is used in claim 1 (i.e., in claim 1 an enhanced device is a device that cooperates with a data collector to gather information therefrom – see claim 1 preamble). Instead, Rothschild's timing label generates a warning signal that is perceptible by a human without using an additional data collecting device (see col. 4, lines 14-20 in this regard).

Second, Rothschild fails to teach or suggest descriptors that are associated with each order that can be used to identify an indicating configuration associated with the order as required by the claim 1 preamble. To this end, Rothschild only discusses timing type labels and does not contemplate that more than one label type may be provided by a single system and therefore it would make no sense for Rothschild to teach a descriptor that indicates the type of label required (i.e., Rothschild only contemplates a single label type and in fact never discusses or suggests a printed label of any type). Also, in this regard, Rothschild's count value is provided by a system operator (i.e., a person) and not by a descriptor usable to

identify an indicating configuration and the date to be stored via the indicating configuration.

Third, because Rothschild does not contemplate a descriptor associated with each order, not surprisingly, Rothschild cannot and does not teach or suggest a reader for reading each descriptor. When an operator of Rothschild's system enters an end date to specify a period duration to be timed, Rothschild's system converts the end date to a count value and directly programs a binary counter 26 so that, even if the count value were some how construed to be a descriptor, the count value is not read by a reader but rather is directly programmed into the timing label counter 26 (see col. 9, lines 50-62).

Fourth, Rothschild fails to teach or suggest a writer for writing data to enhanced devices. To this end, Applicant recognizes that computer 32 is used to write a count value to Rothschild's timing label, but, as indicated above, Rothschild's timing label is not akin to an enhanced device (i.e., a device that cooperates with a data collector device to gather information) as required by claim 1.

Fifth, because Rothschild does not teach a reader or descriptors, not surprisingly, Rothschild fails to teach or suggest a processor linked to a reader for receiving the descriptors and using the descriptors to identify when enhanced data is associated with an order.

Sixth, Rothschild does not teach or suggest orders associated with containers. In this regard, Rothschild simply teaches that a system user can input an end date for a container where the end date is not an order.

Sixth, because Rothschild does not teach or suggest a writer for writing information to enhanced devices, enhanced devices themselves or orders, not surprisingly, Rothschild does not teach or suggest a processor causing a writer to write data to an enhanced device when enhanced data is associated with an order and to cause another indicating function when enhanced data is not associated with an order.

Turning to Foote, Foote only teaches printed labels and does not teach or suggest enhanced devices and therefore, while at least one of Foote's general functions (i.e., to cut time in preparing drug containers for customers – see Foote,

col. 2, lines 9-10) is similar to the function performed by the present invention, the specific function is different (i.e., Foote cannot reduce order filling costs for enhanced and non-enhanced containers as Foote does not contemplate enhanced containers).

With respect to form, Foote accomplishes its function by providing a single label blank that includes several portions that are useable to print information to be included with a medical vial. In this regard, the blank includes separate label portions (see 96-126 in Fig. 2) that each include adhesive that can be used to provide general medicant information as well as required warnings and instructions. In addition, the exemplary blank includes non-adhesive sections 86, 88 and 90 that can be used to print other more detailed instructions or the like. Information is printed on the different label sections as needed, printed sections are removed from a backing 82 and applied to a container and unused label sections of the label blank are discarded (see col. 5, lines 13-20).

Specifically, Foote fails to teach the following claim 1 limitations. First, Foote does not teach or even remotely suggest enhanced memory devices. Second, Foote fails to teach or suggest a writer for writing data to enhanced devices (indeed Foote cannot teach writing to enhanced devices as Foote does not contemplate enhanced devices). Third, Foote fails to teach or suggest a processor that uses a descriptor to identify when enhanced data is associated with an order and that causes a writer to write enhanced data to an enhanced device when enhanced data is associated with an order. Fourth, Foote fails to teach a processor that causes another indicating function to be performed when enhanced data is not associated with an order.

Even if Rothschild and Foote could be read together in some way as, in combination, teaching all of the limitations of claim 1, neither of the references teaches or suggests combining with the other reference or anything akin thereto. In fact, because the Rothschild and Foote functions are completely different (i.e., Rothschild's function is to provide a warning when a time period associated with a product has lapsed while Foote's function is to reduce container configuration costs and the time required to configure containers), it is clear that one of ordinary skill in

the container configuring arts would not be motivated to combine the two references to provide the synergies of the claim 1 invention.

For all of the above reasons Applicant believes claim 1 and claims dependent therefrom are patently distinct over Rothschild in view of Foote.

With respect to the claims that depend from claim 1, neither of Rothschild or Foote teach or suggest many of the dependent claim limitations. To this end, the following claims and corresponding limitations are not taught or suggested by the cited references.

Claims 2 and 27 (a descriptor database storing information to be written to enhanced devices);

Claim 3 (an order queue);

Claims 6 and 8 (at least a subset of descriptors indicate that no data should be written to enhanced devices);

Claim 7 (including an enhanced container device);

Claims 9 and 18 (including enhanced and non-enhanced container sources or label sources where non-enhanced containers are provided when no data is to be written to an enhanced device);

Claims 10 and 19 (where the enhanced source or label includes an enhanced device source and a device attacher where the attacher receives non-enhanced containers or labels and attaches enhanced devices to the containers or labels when an enhanced container or label is required);

Claim 21 (where the processor sequences indicia printing and data writing such that indicia and data corresponding to the same descriptor are provided on the same container);

Claim 22 (wherein the indicia and data are printed and written to a label single label at the same time;

Claim 23 (where cycles separate printing and writing data and cycles are tracked to ensure that associated print and data are provided on the same label);

Claim 25 (including a container source wherein the source provides containers with attached descriptors);

Claim 32 (including a hand held reader for reading the descriptor); and

Claim 33 (wherein the hand held device also includes the writer.

For these reasons also Applicant believes these claims are independently patentable over Rothschild in view of Foote. To the extent that the examiner continues to maintain the rejections of the above claims, Applicant requests that the Examiner point out specific sections of the cited references that teach or at a minimum suggest the claim limitations so that Applicant can respond to the Examiner's positions.

Claim 35 requires, among other things, an enhanced container source including attached enhanced devices, a non-enhanced container source, a processor for determining when an enhanced container is required and providing an enhanced container when an enhanced container is required wherein the processor also provides enhanced data when required. As indicated above, none of the references contemplates an apparatus including both an enhanced container source and a non-enhanced container source and therefore none of the references could possibly contemplate a system including a processor equipped to control both sources or a processor for determining when an enhanced container is required.

With respect to claim 36, neither cited reference teaches an order queue, much less a queue that includes descriptors that indicate when an enhanced device is required.

With respect to claim 40, claim 40 requires a descriptor on a label that indicates data to be written to an enhanced device. Neither of the cited references teaches a descriptor of this type generally or, more specifically, on a label attached to a container.

With respect to claim 42, claim 42 is drawn to a system for identifying and storing a record of medicant users that use interactive systems (i.e., systems that read enhanced devices) and subsequently using a processor to automatically determine, via the stored record, when the recipient of an order input via an interface requires an enhanced device. Thus, for instance, a system user may store an indication that John Smith uses an interactive system. Thereafter, when a physician indicates that a prescription is for John Smith, the processor automatically

determines that an enhanced device is to be included with the container. When an enhanced device is required, the processor indicates so to a configuring system.

Not to belabor the point but, as indicated above, neither Rothschild not Foote contemplates both enhanced and non-enhanced containers and therefore, as one would expect, neither reference appears to suggest a system for indicating or storing indications regarding whether or not medicant users use enhanced containers or a processor that employs anything akin to such an indication.

With respect to claim 43, neither cited reference teaches that orders are stored in a database queue.

With respect to claim 44, neither cited reference teaches that a processor modifies orders prior to storing the orders to indicate enhanced device users.

With respect to claim 46, claim 46 requires an indicator including a descriptor on a container that includes a first segment with human readable indicia and a second machine readable segment useable to determine if an enhanced device including data should be provided on the container. For instance, the indicator may include a label including standard medication information and also include a bar code where the code indicates that an enhanced device is required for the container.

Neither cited reference appears to contemplate an indicator including both human readable indicia and a machine readable segment that indicates that an enhanced device is required.

Claim 48 is drawn to a system for selecting a container type as a function of the area required to provide label information on a container. For instance, on one hand, where a small amount of label information area is required the system may identify a relatively small container for packaging a first item. On the other hand, where a large amount of label information area is required the system may identify a relatively large container for packaging the first item.

Consistent with the above comments, claim 48 requires, among other things, an input device for specifying information about a product to be stored in a container, the product information including label information to be provided on the container exterior, the label information requiring a specific surface area on the



container exterior, a processor for determining a container type based on required surface area and an output device indicating container type.

Perusing the cited references, it appears as though neither of Rothschild or Foote teaches or suggests various container sizes or selecting container sizes based on any type of information, much less based on the area required for label information. Thus, for at least this reason Applicant believes claim 48 and claims dependent therefrom are patently distinct over the cited references.

Claim 50 further limits claim 48 by requiring that the information to be included on the label includes product type and quantity and wherein the processor determines a required container volume based on the product type and quantity information and, wherein, the processor selects the container type at least in part based on the required volume. Again, none of the cited references appears to teach these limitations – i.e., no reference teaches an automated container selection apparatus generally.

Claim 51 requires an output device that indicates container type generally to an apparatus user. Neither cited reference teaches such an output device.

Claim 53 is drawn to a method wherein a sponsor such as a drug manufacturer indicates specific circumstances under which the sponsor will pay for medicant users to use containers including enhanced devices wherein, when a prescription is to be filled, comparing prescription information to the circumstances under which sponsorship exists and then indicates whether or not an enhanced container or a non-enhanced container should be provided to fill a prescription.

To this end, claim 53 includes the steps of providing a sponsorship medication profile database indicating sponsorship conditions, receiving prescription information, comparing the prescription information to the sponsorship conditions and indicating either an enhanced or a non-enhanced container as a function of the comparison.

Nothing in either Rothschild or Foote appears to discuss sponsorship of enhanced device programs and hence a sponsor's database including conditions under which enhanced containers should be provided is not suggested by the references. In addition, again, neither of the references suggests both enhanced

containers and non-enhanced containers as options and therefore a process that determines what type of container to use to fill an order is absent from the references.

Claim 71 includes limitations similar to the limitations in claim 1 and therefore, for the reasons discussed above, Applicant believes claim 71 and claims dependent therefrom are patentable over the references cited.

Claim 91 includes limitations similar to the limitations in claim 35 and therefore, for the reasons discussed above, Applicant believes claim 91 and claims dependent therefrom are patentable over the references cited.

Claim 97 includes limitations similar to the limitations in claim 42 and therefore, for the reasons discussed above, Applicant believes claim 97 and claims dependent therefrom are patentable over the references cited.

Claim 100 is drawn to a system wherein a sponsor such as a drug manufacturer indicates specific circumstances under which the sponsor will pay for medicant users to use containers including enhanced devices wherein, when a prescription is to be filled, a processor compares prescription information to the circumstances under which sponsorship exists and then indicates whether or not an enhanced container or a non-enhanced container should be provided to fill a prescription.

To this end, claim 100 requires a sponsorship medication profile database indicating sponsorship conditions, an input device for receiving prescription information and a processor that compares the prescription information to the sponsorship conditions and indicates either an enhanced or a non-enhanced container as a function of the comparison.

Nothing in either Rothschild or Foote appears to discuss sponsorship of enhanced device programs and hence a sponsor's database including conditions under which enhanced containers should be provided is not suggested by the references. In addition, again, neither of the references suggests both enhanced containers and non-enhanced containers as options and therefore a processor that determines what type of container to use to fill an order is absent from the

references. Similar comments are applicable to claim 112 which includes similar limitations.

Claim 106 is similar to claim 35 except that instead of including enhanced and non-enhanced container sources, claim 106 includes enhanced and non-enhanced label sources. For the same reasons discussed above with respect to claim 35 Applicant believes that claim 106 is distinct over the cited references.

Claim 108 is drawn to a system for attaching enhanced devices to containers at specific locations with respect to data collectors. More specifically, referring to the present Fig. 1, a container cap 100 includes a member 110 that, when positioned appropriately relative an enhanced device 60 on the container, enables a processor in cap 100 to read information from enhanced device 60. Here, mechanical constraints position member 110 in a specific orientation with respect the external surface of the container. In this and many other cases, proper positioning of enhanced device on the container surface is necessary for member 110 to align with device 60.

Claim 108 covers a system for ensuring that device 60 or other similar devices on other containers is applied to the container in the correct position (e.g., an aligned section) to ensure alignment with member 110.

To this end, claim 108 includes a device attacher and a container positioner where the positioner positions a container relative the attacher such that the aligned section receives an enhanced device when the attacher operates to attach a device. None of the references cited teaches that an enhanced device must be aligned on a specific area of a container to ensure reading of information therefrom by a data collector that is mechanically constrained when attached to the container. In this regard, Rothschild fails to teach or suggest a data collector and therefore, not surprisingly, does not specific a specific juxtaposition of the timing label with respect to the container or a data collector. Foote does not contemplate an enhanced device or a data collector.

Claim 130 includes limitations similar to the limitations in claim 1 and therefore, for the reasons discussed above, Applicant believes claim 130 and claims dependent therefrom are patentable over the references cited.

Claim 151 includes limitations similar to the limitations in claim 35 and therefore, for the reasons discussed above, Applicant believes claim 151 and claims dependent therefrom are patentable over the references cited.

Applicant has added new claims 159-163 that are similar to other independent claims previously pending, the only difference being that the enhanced devices, containers and labels have been replaced by electronic memory devices, containers including electronic memory devices and labels including electronic memory devices. These new claims are clearly supported by the specification and therefore do not add new matter.

Applicant has introduced no new matter in making the above amendments and antecedent basis exists in the specification and claims as originally filed for each amendment. In view of the above amendments and remarks, Applicant believes claims 1-158 of the present application recite patentable subject matter and allowance of the same is requested. No fee in addition to the fees already authorized in this and accompanying documentation is believed to be required to enter this amendment, however, if an additional fee is required, please charge Deposit Account No. 17-0055 in the amount of the fee.

Respectfully submitted,

Carlos de la Huerga

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By: 

Michael A. Jaskolski  
Reg. No. 37,551  
Attorney for Applicant  
QUARLES & BRADY, LLP  
411 East Wisconsin Avenue  
Milwaukee, WI. 53202-4497  
(414) 277-5711